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with
see

PATENT
ATTORNEY DOCKET NO.: 044921-5004-US

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

| | | |
|---|---|----------------------------|
| In re Application of : Yatindra PRASHAR <i>et al.</i> |) | |
| |) | |
| U.S. Application No.: 09/674,607 |) | Group Art Unit: Unassigned |
| |) | |
| International Appln. Filing Date: May 5, 1999 |) | |
| |) | |
| Date of National Stage Entry: November 3, 2000 |) | Examiner: Unassigned |
| |) | |
| For: A PROCESS TO STUDY CHANGES IN GENE |) | |
| EXPRESSION IN T LYMPHOCYTES |) | |

BOX PCT

Commissioner for Patents
Washington, D.C. 20231

RESPONSE TO NOTIFICATION OF MISSING REQUIREMENTS
UNDER 35 U.S.C. § 371 IN THE U.S. DESIGNATED/ELECTED OFFICE (DO/EO/US)

1. This replies to the Notification of Missing Requirements (Form PCT/DO/EO/905) mailed May 14, 2001.

A copy of the Notification of Missing Requirements (Form PTC/DO/EO/905) is enclosed.

2. Declaration Or Oath

- ☒ No declaration or oath was filed. Enclosed is the original Combined Declaration and Power of Attorney.
- ☐ The specification attached to the declaration is a copy of the specification and any amendments thereto which were filed in the PTO to obtain the filing date.
- ☐ The declaration or oath which was filed was determined to be defective. A new original Combined Declaration and Power of Attorney is attached.

3. English Translation of Non-English Language Papers

☐ Submitted herewith is a verified English translation of the non-English language application papers as originally filed. It is requested that this translation be used as the copy for examination purposes in the PTO.

☐ Also enclosed is the Verification of Translation Document

4. Small Entity Statement(s)

☒ Applicant(s) hereby assert small entity status.

5. Fee Calculation

| | | | | | |
|---|---------------------|-------|--------------------------------|---------------|-----------------|
| Basic Fee: PCT Application-\$890.00 | | | | | \$890.00 |
| | Claims Remaining | | Highest no. previously paid | present extra | |
| Total Claims | 38 | minus | 38 | 0 | +\$? |
| Independent Claims | 10 | minus | 10 | 0 | +\$? |
| Multiple dependent claim(s), if any | | | | \$280.00 | +\$? |
| Missing Requirements Surcharge Fee | | | | \$130.00 | \$130.00 |
| SUB-TOTAL = | | | | | \$130.00 |
| Reduction by 1/2 for filing by small entity | | | | | 65.00 |
| Fee For Application Filed With A Non-English Specification (37 C.F.R. § 1.17(k) and § 1.52(d)) | | | | \$130.00 | +\$? |
| Fee For Processing and retention of application (37 C.F.R. § 1.21(l) and § 1.53(d)) | | | | \$130.00 | +\$? |
| TOTAL FILING FEE = | | | | | \$ 65.00 |

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6. Extension of Time

The proceedings herein are for a patent application and the provisions of 37 C.F.R. § 1.136(a) apply.

- ☒ Applicants petition for an extension of time, the fees for which are set out in 37 C.F.R. §§ 1.17(a)-(d), for the total number of months checked below:

| <u>Total months requested</u> | <u>Fee for extension</u> | <u>fee for Small Entity</u> |
|---|--------------------------|-----------------------------|
| <input type="checkbox"/> one month | \$ 110.00 | \$ 55.00 |
| <input type="checkbox"/> two months | \$ 400.00 | \$200.00 |
| <input type="checkbox"/> three months | \$ 920.00 | \$460.00 |
| <input checked="" type="checkbox"/> four months | \$1,440.00 | \$720.00 |

Extension of time fee due with this request: **\$720.00**

If an additional extension of time is required, please consider this a Petition therefor.

- ☐ Applicant believes that no extension of time is required. However, this conditional petition is being made to provide for the possibility that applicant has inadvertently overlooked the need for a petition and fee for extension of time.

7. Fee Payment

| | | |
|-----------------------|--------------------------------|------------------------|
| The total fee due is: | Missing Requirements Surcharge | \$ 65.00 |
| | Extension Fees | \$720.00 |
| | Total Fee Due | <u>\$785.00</u> |

- ☒ The Commissioner is hereby authorized to charge \$785.00 representing the Missing Requirements Surcharge and a 4-month Extension of Time fee to Deposit Account No. 50-0310.

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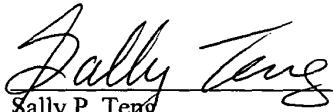
- ☐ **Except** for issue fees payable under 37 C.F.R. §1.18, the Commissioner is hereby authorized by this paper to charge any additional fees during the entire pendency of this application including fees due under 37 C.F.R §1.16 and §1.17 which may be required, or credit any overpayment to Deposit Account No. 50-0310.

8. Additional papers enclosed.

- ☐ Form PCT/IPEA/409 (English Translation)
☐ Preliminary Amendment
☐ PCT/IB/338 English translation of the International preliminary Examination Report
☒ Information Disclosure Statement
☒ Form PTO-1449, 15 documents as listed
☐ Declaration of Biological Deposit
☐ Submission of "Sequence Listing", computer readable copy and/or amendment pertaining thereto for biotechnology invention containing nucleotide and/or amino acid sequence.

Respectfully submitted,

MORGAN, LEWIS & BOCKIUS LLP


Sally P. Teng
Reg. No. 45,397

Date: November 14, 2001

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MAY 15 2001



UNITED STATES PATENT AND TRADEMARK OFFICE

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 Commissioner for Patents, Box P-01
 United States Patent and Trademark Office
 Washington, D.C. 20231
 www.uspto.gov

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|---------------------------------------|----------------------------|------------------|
| U.S. APPLICATION NO. | FIRST NAMED APPLICANT | ATTY. DOCKET NO. |
| 09/674607 | PRASHAR | Y |
| INTERNATIONAL APPLICATION NO. | | |
| Docketed 5-15-01 Attorney MST/MST/SPT | | PCT/US99/09761 |
| MORGAN, LEWIS & BOCKIUS | Case 44921-5004 | |
| 1800 M STREET NW | Due Date 7-14-01 | |
| WASHINGTON, DC 20036 5869 | Action Missing Requirement | |
| By SDW | Chk 450 | |
| I.A. FILING DATE | PRIORITY DATE | |
| 05 MAY 99 | 05 MAY 98 | |

DATE MAILED: 14 MAY 2001

NOTIFICATION OF MISSING REQUIREMENTS UNDER 35 U.S.C. 371 IN THE UNITED STATES DESIGNATED/ELECTED OFFICE (DO/EO/US)

1. The following items have been submitted by the applicant or the IB to the United States Patent and Trademark Office as ☐ a Designated Office (37 CFR 1.494) ☒ an Elected Office (37 CFR 1.495):

- | | |
|--|---|
| <input checked="" type="checkbox"/> U.S. Basic National Fee. | <input type="checkbox"/> Indication of Small Entity Status. |
| <input checked="" type="checkbox"/> Copy of the international application. | <input type="checkbox"/> Translation of the international application into English. |
| <input type="checkbox"/> Oath or Declaration of inventors(s). | <input type="checkbox"/> Translation of Article 19 amendments into English. |
| <input type="checkbox"/> Copy of Article 19 amendments. | <input type="checkbox"/> Other: |
| <input type="checkbox"/> Priority Document. | |
| <input checked="" type="checkbox"/> The International Preliminary Examination Report in English and its Annexes, if any. | |
| <input type="checkbox"/> Translation of Annexes to the International Preliminary Examination Report into English. | |

2. ☐ Applicant has requested early processing under 35 U.S.C. 371(f) but has not filed the following indicated items and/or the indicated items in paragraph 3 below. The Basic National Fee and the copy of the international application must be filed prior to 20 or 30 months from the priority date to avoid abandonment.

- | | |
|---|---|
| <input type="checkbox"/> U.S. Basic National Fee. | <input type="checkbox"/> Copy of the international application. |
|---|---|

3. The following items **MUST** be furnished within the period set forth below in order to complete the requirements for acceptance under 35 U.S.C. 371:

- | |
|--|
| <input type="checkbox"/> a. Translation of the application into English. A processing fee will be required if submitted later than the appropriate 20 or 30 months from the priority date. |
| <input type="checkbox"/> The current translation is defective for the reasons indicated on the attached Notice of Defective Translation. |
| <input type="checkbox"/> b. Processing fee for providing the translation of the application and/or the Annexes later than the appropriate 20 or 30 months from the priority date (37 CFR 1.492(f)). |
| <input checked="" type="checkbox"/> c. Oath or declaration of the inventors, in compliance with 37 CFR 1.497(a) and (b), properly identifying the application (preferably by the International application number and international filing date). A surcharge will be required if submitted later than the appropriate 20 or 30 months from the priority date. |
| <input type="checkbox"/> The current oath or declaration does not comply with 37 CFR 1.497(a) and (b) for the reasons indicated on the attached PCT/DO/EO/917. |
| <input checked="" type="checkbox"/> d. Surcharge for providing the oath or declaration later than the appropriate 20 or 30 months from the priority date (37 CFR 1.492(e)). |

4. Additional claim fees of \$_____ as a ☐ large entity ☐ small entity, including any required multiple dependent claim fee, are required. Applicant must submit the additional claim fees or cancel the additional claims for which fees are due (37 CFR 1.492(g)). See attached PTO-875.

5. ☐ Applicant has not submitted the required sequence listing pursuant to 37 CFR 1.821-1.825. See attached PCT/DO/EO/920.

ALL OF THE ITEMS SET FORTH IN 3(a)-3(d), 4 AND 5 ABOVE MUST BE SUBMITTED WITHIN TWO (2) MONTHS FROM THE DATE OF THIS NOTICE OR BY 22 OR 32 MONTHS (where 37 CFR 1.495 applies) FROM THE PRIORITY DATE FOR THE APPLICATION, WHICHEVER IS LATER. FAILURE TO PROPERLY RESPOND WILL RESULT IN ABANDONMENT.

The time period set above may be extended by filing a petition and fee for extension of time under the provisions of 37 CFR 1.136(a).